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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,626	07/13/2001	Changuan Fan	42390P12061	3702
21906	7590	04/07/2005	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			SHIN, KYUNG H	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/905,626	Applicant(s) FAN ET AL.	
	Examiner Kyung H Shin	Art Unit 2143	

→ The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responding to application papers filed 7/13/2001.
2. Claims 1 - 12 are pending. Independent claims are 1, 8, 10. Claims 1, 2, 3 have been amended. Claims 4 - 7 have been canceled. **Claims 8 - 12 are new.**

Response to Arguments

3. Applicant's arguments with respect to claim 1-12 have been considered but are moot in view of the new ground(s) of rejection.
4. The text of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

5. **Claims 1, 2, 8, 10 are rejected under 35 U.S.C. 102(e) as being anticipated over Kikinis (US Patent No. 6,622,169).**

Regarding Claim 1 (Currently Amended), Kikinis discloses a method, comprising:

- a) receiving, at an Internet service provider, a request from a client device for Internet service; (see Kikinis col. 3, lines 28-32: user (i.e. client) request for internet access configuration information from ISP) and
- b) downloading provisioning (see Kikinis col. 5, lines 1-6: device (i.e. internet based) configuration equivalent to provisioning; Applicant specification, paragraph

[0006], lines 6-8: “ ... *the terms “configure” and “provision” will be used somewhat interchangeably ...*”) data to the client device to enable the client device to receive an Internet service from said Internet service provider. (see Kikinis col. 6, line 66 - col. 7, line 8: download configuration information to complete internet access setup)

Regarding Claim 2 (Currently Amended), Kikinis discloses the method of claim 1, further comprising: authenticating the generically pre-provisioned client device; and the downloading being conditioned upon the authenticating. (see Kikinis col. 7, lines 4-6; col. 8, lines 52-57; authentication information required before internet access, setup completed)

Claims 4-7 (Canceled).

Regarding Claim 8 (New), Kikinis discloses a processor-based system comprising:

- a) a provisioning agent to enable said system to acquire from an Internet service provider the information the system needs to make an initial connection; (see Kikinis col. 3, lines 43-53; col. 4, lines 31-36: server based system, information required for initial connection) and
- b) a storage, coupled to said agent, to store said information. (see Kikinis col. 6, lines 11-21: information storage capability)

Regarding Claim 10 (New), Kikinis discloses a processor-based system comprising:

- a) a provisioning server to enable said system to respond to a client request with information the client needs to make an initial connection to the server, (see Kikinis col. 4, lines 31-36; col. 3, lines 28-32: server (i.e. provisioning server) to configure apparatus (i.e. internet appliance) resulting from client request) and
- b) an address server coupled to said provisioning server. (see Kikinis col. 6, lines 3-4; col. 6, lines 9-12: server providing stored and storing addressing configuration information)

Claim Rejection - 35 USC § 103

6. Claims 3, 9, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Ylonen (US Patent No. 6,782,474).

Regarding Claim 3 (Currently Amended), Kikinis discloses an apparatus that provides a pre-configured network connected appliance that is capable of obtaining its configuration information from server. (see Kikinis col. 3, lines 22-27: apparatus (i.e. internet device) capable of obtaining and installation of configuration information) Kikinis does not specifically disclose an out-of-band method such as e-mail, phone call, or any other non-network method for receipt of authentication information. However, Ylonen discloses the method of claim 2, further comprising: sending out-of-band data to a user of the client device prior to receiving the connection. (see Ylonen col. 7, lines 56-61; col. 9, lines 15-23: receive authentication information via out-of-band method)

It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to modify Kikinis to obtain access and authentication information via an out-of-band method as taught by Ylonen. One of ordinary skill in the art would be motivated to modify Kikinis in order to remotely configure a network connected appliance obtaining its configuration information from a network server. (see Ylonen col. 2, lines 55-56: “ ... *configuration methods for configuring network devices ... ease of use, robustness, and security* ... ”; col. 2, line 67 - col. 3, line 7: “ ... *where security is an issue, it is desirable to be able to configure new network devices remotely and securely from a remote network management station* ... ”)

Regarding Claim 9 (New), Kikinis discloses an apparatus (i.e. internet appliance) with remote configuration capability. (see Kikinis col. 3, lines 22-27: apparatus (i.e. internet device) capable of obtaining and installation of configuration information) Kikinis does not specifically disclose an out-of-band method for the receipt of authentication information. However, Ylonen discloses the system of claim 8 including an out-of-band communication interface. (see Ylonen col. 7, lines 56-61; col. 9, lines 15-23: receive authentication information via out-of-band method)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain access and authentication information via an out-of-band method as taught by Ylonen. One of ordinary skill in the art would be motivated to modify Kikinis in order to remotely configure a network connected appliance obtaining its configuration information from a network server. (see Ylonen col. 2, lines 55-56; col. 2, line 67 - col. 3, line 7)

Regarding Claim 11 (New), Kikinis discloses an apparatus (i.e. internet appliance) with remote configuration capability. (see Kikinis col. 3, lines 22-27: apparatus (i.e. internet device) capable of obtaining and installation of configuration information) Kikinis does not disclose a static address usage capability. However, Ylonen discloses the system of claim 10 including a static address server capability. (see Ylonen col. 4, lines 22-27: receipt of a static (i.e. pre-configured or pre-setup) address for a network node)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain a static address for internet access as taught by Ylonen. One of ordinary skill in the art would be motivated to modify Kikinis in order to remotely configure a network (i.e. internet) connected appliance obtaining its configuration information from a network server. (see Ylonen col. 2, lines 55-56; col. 2, line 67 - col. 3, line 7)

Regarding Claim 12 (New), Kikinis discloses an apparatus (i.e. internet appliance) with remote configuration capability. (see Kikinis col. 3, lines 22-27: apparatus (i.e. internet device) capable of obtaining and installation of configuration information) Kikinis does not specifically disclose a dynamic address usage capability. However, Ylonen discloses the system of claim 10 including a dynamic address server. (see Ylonen col. 4, lines 35-38: receipt of a dynamic address for a network node)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to obtain a dynamic address for internet access as taught

by Ylonen. One of ordinary skill in the art would be motivated to modify Kikinis in order to remotely configure a network (i.e. internet) connected appliance obtaining its configuration information from a network server. (see Ylonen col. 2, lines 55-56; col. 2, line 67 - col. 3, line 7)

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KHS

Kyung H Shin
Patent Examiner
Art Unit 2143

KHS
Mar. 23, 2005

William C. Vaughn
Primary Examiner
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William C. Vaughn